

REMARKS

In accordance with the foregoing, claims 14-19 are amended. No new matter is added. Claims 1-35 are pending and under consideration.

CLAIMS REJECTIONS UNDER 35 U.S.C. §103

Claims 1-35 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,539,418 to Schneider et al (hereinafter "Schneider"), in view of U.S. Patent Application Publication No. 2004/0042547 to Coleman ("Coleman") and further in view of U.S. Patent No. 6,721,950 to Lupu ("Lupu").

Claim 1 is directed to a switch "that selectively switches from one terminal to another among a plurality of terminals to which a computer is connected, and that can be remotely operated by a remote-control computer connected to a predetermined network." The Office Action asserts that the preamble of claim 1 is anticipated by FIGS. 1A-1C of Schneider and respective descriptions.

The Office Action submits that Schneider "does not fully teach the switch" and specifically does not anticipate the structural elements of the switch recited in claim 1. Further, the Office Action alleges "In the same field of endeavor, Coleman teaches the switch" with the recited structural elements. However, Coleman is directed to a "method and apparatus for digitizing and compressing video signals between a remotely located computer and a host or local computer" (see Coleman's Abstract). There is **no switch** in Coleman.

Relative to the "information acquiring unit that acquires cursor location information from the remote-control computer" of claim 1, the Office Action indicates paragraphs [0017] and [0163] of Coleman as being relevant. The indicated paragraphs discuss the use of image redundancies to minimize the video information volume by taking advantage of the redundancies and providing only information about changes between frames. A blinking cursor image is an example provided in Coleman. However, Coleman does not teach a switch, and, moreover, a switch comprising "**an information acquiring unit that acquires cursor location information from the remote-control computer.**"

Relative to the image extracting unit, numerous citations of Coleman are advanced to allegedly point out the image extracting unit and the corresponding recitations in claim 1. However, this abundance of citations does not pass a scrutiny of coherency. For example, elements 401 and 221 of Coleman which are indicated as corresponding to the image extracting

unit, do not perform extracting a cursor peripheral image as allegedly disclosed in paragraphs [0017], [0162] and [0163].

Additionally, Applicants challenge the Office Action's assertion in item 6 at page 3, that it would have been obvious to one having ordinary skill in the art to combine the transmission system of Coleman with Schenider's switch. The alleged reason of "transmitting video data across a network without significant loss to image quality" (see first line on page 4 of the Office Action) is irrelevant as to the switch of claim 1, which aims to switch among terminals and not to transmit video data over a network.

The Office Action then invokes Lupu's teachings to correct or compensate for some of the above identified failures of Schneider and Coleman. Lupu is directed to a computer method for redirecting input messages to an application that has at least one window redirected (i.e. repositioned). Once again, the cited prior art reference, Lupu, which is alleged to be from "the same field of endeavor" has **no switch** and does not deal with problems similar to the current application. Only by using impermissible hindsight, one would allege that a structure of a device (the switch of claim 1) is rendered obvious by unrelated computer methods as disclosed in Coleman and Lupu. The Office Action picks mere functionality from Coleman and Lupu, and then backprojects it into the cited structure to support of the obviousness allegation. *In re Rouffet*, 149 F.3d 1350, 1357 sets forth criteria for being certain that impermissible hindsight is not being used to deprecate an invention:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to **show** a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, **confronted with the same problems as the inventor and with no knowledge of the claimed invention**, would select the elements from the cited prior art references for combination in the manner claimed. [emphasis added]

Therefore, the cited prior art fails to teach or suggest every feature recited in Applicant's claims, so that claim 1 and claims 2-10 depending directly or indirectly from claim 1, are patentably distinct over the prior art. Accordingly, Applicants respectfully traverse, and request reconsideration of, the rejection based on Schneider, Coleman and Lupu.¹

Independent claim 11 is directed to an image transmission apparatus that transmits an

¹ See MPEP 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

image to an information processing apparatus connected to a predetermined network. The image transmission apparatus of claim 11 includes an information acquiring unit, an image extracting unit, and a cursor image transmitting unit. The Office Action does not meet the requirements of making a *prima facie* case of obviousness relative to claim 11², but it merely states "With regard to claim 11, it is similarly analyzed as claim 1, and therefore rejected under the same rationale." Applicants respectfully submit that claim 11 and claims 12 and 13 depending from claim 11 are patentable at least because the prior art references alone or in combination fail to render obvious "an image extracting unit that extracts a cursor peripheral image from an image storing unit that stores the image to be transmitted to the information processing apparatus, based on the cursor location information acquired by the information acquiring unit."

Independent claim 14 is directed to a method of transmitting an image to an information processing apparatus connected to a predetermined network. The Office Action rejects claim 14 by merely stating "With regard to claim 14, it is similarly analyzed as claim 1, and therefore rejected under the same rationale." Applicants respectfully submit that claim 14 recites a method while claim 1 is directed to a switch. Claim 14 and claims 15-23 depending directly or indirectly from claim 14 patentably distinguish over the cited prior art at least because claim 14 recites "extracting a cursor peripheral image from an image storing unit that stores the image to be transmitted to the information processing apparatus, based on the cursor location information acquired in the information acquiring."

Relative to independent claim 24, as argued above, Schneider, Coleman, and Lupu, alone or in combination, fail to render obvious at least "acquiring cursor location information." Coleman discloses transmitting only pixel values changed in sequential frames, for example due to a blinking of a mouse, but **cursor location information** is not acquired in Coleman.

Independent claim 25 is directed to an "image transmitting program product for operating a computer that transmits an image to an information processing apparatus connected to a predetermined network." As in the case of claim 14, the Office Action rejects claim 25 by merely stating "With regard to claim 25, it is similarly analyzed as claim 1, and therefore rejected under the same rationale." Applicants respectfully submit that claim 25 recites operations of a method while claim 1 is directed to a switch. Claim 25 and claims 26-34 depending directly or indirectly

² See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

from claim 25 patentably distinguish over the cited prior art at least because claim 25 recites "an information acquiring unit that acquires cursor location information from the information processing apparatus" and "an image extracting unit that extracts a cursor peripheral image [...] based on the cursor location information."

Independent claim 35 patentably distinguishes over the cited prior art at least by reciting "an information acquiring unit that acquires **cursor location information**" and "an image combining unit that combines a first image obtained from the information processing apparatus with a second image in accordance with the **cursor location information** [...]."

Applicants respectfully request the Examiner to refrain from making the next Office Action "FINAL" because the lack of properly supported rejections relative to independent claims 11, 14, and 25, in the current action, as specified hereinabove, deprived Applicants of the chance to respond and/or put forth additional arguments for patentability of claims 11-23, and 26-34 (including the claims depending respectively from these independent claims).

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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